

REMARKS

In the May 1, 2003 Office Action, the Examiner noted that claims 1-18 were pending in the application, but that claims 4-8, 12-16 and 18 had been withdrawn due to the restriction requirement; noted that the Costales et al. reference on Form 1449 submitted with the Information Disclosure Statement on May 25, 2000 was not received by the Examiner; suggested modification of the headings to avoid giving a reader the impression that the Background of the Invention is missing; maintained the Restriction Requirement; rejected claims 2, 3, 10 and 11 under the second paragraph of 35 U.S.C. § 112; and rejected claims 1-3, 9-11 and 17 under 35 U.S.C. § 103(a). In rejecting the claims U.S. Patents 6,546,416 to Kirsch and 5,765,033 to Miloslavsky (References A and B, respectively) were cited. Claims 1-3, 9-11 and 17 remain pending for examination. The Examiner's rejections are traversed below.

Supplemental Information Disclosure Statement

A Supplemental Information Disclosure Statement is submitted herewith providing another copy of the Costales et al. reference, since the copy provided on May 25, 2000 did not reach the Examiner. Consideration of the Costales et al. reference is respectfully requested.

Comments Regarding Specification

In the third paragraph on page 2 of the Office Action, the Examiner suggested centering the heading "Background of the Invention" or indenting the two subheadings "Field of the Invention" and "Description of the Related Arts". No changes to the specification have been made, because it is understood that the suggested changes are made automatically when a patent application or patent is published by the U.S. Patent and Trademark Office. Submitted herewith as Exhibit A is a copy of page 1 of the patent application assigned Serial No. 08/738,709. Submitted as Exhibit B is the first page of the specification of Serial No. 08/738,709 when it was published as U.S. 2003/0046564 A1. It should be readily apparent that the format of the headings in Exhibit A are identical to those in the subject application and that there was no difficulty on the part of the USPTO to format the headings appropriately.

The Invention

The present invention is directed to a device and method for blocking junk email. As described on pages 8-11 of the application, the present invention can be used in a system in which users are permitted to use a large number of email addresses that are delivered to a

single destination. As a result, it is very easy to quarantine or delete email addressed to one or more email addresses. This overcomes the problem of conventional systems that rely upon the email address of the sender to control how received email is handled. In an embodiment, an encrypted command may be inserted into the destination email address to identify how the email should be processed.

The Prior Art

U.S. Patent 6,546,416 to Kirsch

The Kirsch patent is directed to a method and system for selectively blocking delivery of bulk electronic mail based on the "origin address" (Abstract, line 1). When an e-mail message is received from an unverified source address, a challenge is issued and only if a response is received to the challenge is the message placed in the inbox of the recipient.

U.S. Patent 5,765,033 to Miloslavsky

The Miloslavsky patent is directed to a system for routing electronic mail that uses a database to store "information related to all persons who can answer e-mails ... [and] a server ... storing the history of all activities in the system" (Abstract, lines 7-10). An information extractor extracts relevant information from e-mail. A router uses the extracted relevant information, the database and the history stored by the server to determine how the e-mail should be routed. The information that is extracted may include "the addresses of the sender and recipient" (column 4, line 34).

Rejections under 35 U.S.C. § 112 Second Paragraph

In the last paragraph on page 4 and first paragraph on page 3 of the Office Action, claims 2, 3, 10 and 11 were rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness because allegedly "there is no functional relationship between the specifying unit and the components of ... claim 1" (Office Action, page 3, lines 1-2). Claims 2, 3, 10 and 11 have been amended to clarify the relationship between the limitations added by these claims and the claims from which they depend. Therefore, withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 is respectfully requested.

Rejection under 35 U.S.C. § 103(a)

On pages 3 and 4 of the Office Action, claims 1-3, 9-11 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kirsch in view of Miloslavsky. As discussed above, Kirsch only uses the origin or source address of e-mail in determining how the e-mail will be handled. Although Miloslavsky discloses at column 4, line 34 that the addresses of both the sender and the recipient are extracted as part of the relevant information, the only subsequent use of the word "recipient" is at column 5, line 47 in regard to a reply message where the recipient is the sender of the original e-mail. The reason that the system taught by Miloslavsky does not consider the recipient address to be very important is that in the disclosed embodiment the system is used for routing e-mail to support personnel and "there is no guarantee that the intended recipient is available to reply to the e-mail" (column 2, lines 6-8).

The rejected independent claims have been amended to clarify that the extracted mail address indicates "a destination" (e.g., claim 1, line 2) and the storing unit stores "a particular destination mail address or destination address pattern" (e.g., claim 1, line 5). It is submitted that the prior art contains no teaching or suggestion of using destination mail addresses or patterns to block junk email. Therefore, it is submitted that claims 1-3, 9-11 and 17 patentably distinguish over the prior art.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-3, 9-11 and 17 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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